UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,378	03/12/2004	Cheri A. Anaclerio	1215-0490P	5649

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ANDREWS KURTH LLP
1350 I STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005

EXAMINER
MAI, TAN V

ART UNIT	PAPER NUMBER
2193	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/798,378	ANACLERIO ET AL.
	Examiner	Art Unit	
	Tan V. Mai	2193	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As per amended claims 1 & 12, the claims add the "thereby producing the

customized filter ..." feature. The phrase seems to be vague and indefinite because the

"computer-implemented method" only provides information, i.e., the data for "build" the

filter, not the actual filter. Clarification requested.

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Rejection grounds continue to be those set forth in the previous office action

(Paper dated 6/20/07, paragraph 1).

4.   Applicants' arguments filed on 9/20/07 have been fully considered but they are

not persuasive.

Applicants, in their remarks, argue that:

"[c]laims 1 and 12 are amended to recite a computer-implemented method for designing a

customized filter. The method produces a customized filter having nearly ideal responses in both

the frequency domain and the time domain, which is concrete, useful, and tangible result. See

State Street Bank v. Signature Financial Group, Inc., 47 U.S.P.Q.2d 1596, 1601 (Fed. Cir. 1998)

(holding that a price for a financial product is a concrete, useful, and tangible restllt). Therefore,

claims 1 and 12 (and their respective dependent claims) contain statutory subject matter tinder 35

U.S.C. § 101. Withdrawal of the rejection of claims 1-15 under 35 U.S.C. §101 is respectfully

requested" (emphasis added).

With respect to the arguments, the examiner carefully reviews Applicant's

specification and claimed invention. It is noted that applicants haven't pointed out

how/why the claim produces a **useful, concrete, and tangible result**. If the claim as a

whole is reasonably interpreted as just solving a mathematical algorithm rather than

reciting a **practical application** of the algorithm which produces a useful, concrete and

tangible result, then it would be non-statutory. In order for claims to be statutory, claims

must include a practical application with a concrete, useful, and tangible result.

However, claims 1-15 merely disclose elements for performing mathematical function

without disclosing a **practical application with a concrete, useful, and tangible

result, as they are pre-emptive in any application**. Therefore, claims 1-15 are

directed to non-statutory subject matter. Therefore, the rejection is still proper.

5.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR

1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tan V. Mai whose telephone number is (571) 272-3726.

The examiner can normally be reached on Mon-Wed and Fri. from 9:30am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Meng-Ai An, can be reached on (571) 272-3756. The fax phone number for

the organization where this application or proceeding is assigned is:

        Official   (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (571) 272-

2100.

Tan V. Mai
Primary Examiner